

REMARKS

Summary of the Office Action

Claims 10-12, 14-19, and 28-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,794,833 to *Straat*.

Claims 20-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Straat*, in view of U.S. Patent No. 7,048,165 to *Haramiishi*.

Summary of the Response to the Office Action

Applicants respectfully submit that the features of the present invention are not taught or suggested by the applied references of record. Accordingly, claims 10-12, 14-21, and 28-30 are presently pending.

The Rejections Under 35 U.S.C. § 102(b)

Claims 10-12, 14-19, and 28-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Straat*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Straat* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Independent claim 10 recites, in part, "an opening, formed at a part of the staple case, and through which a member for rotating the roll staple is brought into contact with a circumferential surface of the roll staple, wherein a direction from a center of the roll staple to the opening and a tangent line of a portion of the roll staple where the

member is brought into contact with the circumferential surface of the roll staple are substantially orthogonal." *Straat* fails to teach or suggest at least these features of claim 10.

The Office Action equates the recesses (29) of *Straat* of the two casing halves (10) forming the claimed opening and holding the roll (9). No other components relating to the other recited features of claim 10 are identified in the Office Action from the *Straat* drawings. *Straat* does not disclose "an opening, formed at a part of the staple case, and through which a member for rotating the roll staple is brought into contact with a circumferential surface of the roll staple, wherein a direction from a center of the roll staple to the opening and a tangent line of a portion of the roll staple where the member is brought into contact with the circumferential surface of the roll staple are substantially orthogonal," but rather the "member for rotating the roll" (feeding element 34, feeders 36) in *Straat* is brought into contact with roll (9) near the front opening (14). See Figs. 3 and 8 and col. 4, lines 17-67 of *Straat*. Because the feeding element (34) at the claimed opening is forward of the outer circumferential surface of the roll (9), the "direction from a center of the roll staple to the opening and a tangent line of a portion of the roll staple where the member is brought into contact with the circumferential surface of the roll staple are substantially orthogonal," limitations cannot be met by *Straat*. See Figs. 3 and 8 of *Straat*. Accordingly, *Straat* fails to teach or suggest each and every feature of claim 10. Thus, the rejection of claim 10 should be withdrawn.

As pointed out in M.P.E.P § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the

rejection under 35 U.S.C. § 102(b) should be withdrawn because *Straat* does not teach or suggest each feature of independent claim 10.

Additionally, Applicants respectfully submit that dependent claims 11-12, 14-19, and 28-30 are also allowable insofar as they recite the patentable combinations of features recited in claim 10, as well as reciting additional features that further distinguish over the applied prior art.

The Rejections Under 35 U.S.C. § 103(a)

Claims 20-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Straat*, in view of *Haramiishi*. Applicants respectfully traverse the rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see M.P.E.P §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because *Straat* and *Haramiishi*, whether alone or in combination, fail to teach or suggest all the recited features of independent claim 10. Independent claim 10 recites, in part, “an opening, formed at a part of the staple case, and through which a member for rotating the roll staple is brought into contact with a circumferential surface of the roll staple, wherein a direction from a center of the roll staple to the opening and a tangent line of a portion of the roll staple where the member is brought into contact with the circumferential surface of the roll staple are substantially

orthogonal.” *Straat* and *Haramiishi*, whether taken alone or in combination, fail to teach or suggest at least these features of claim 10.

As previously demonstrated, *Straat* fails to teach or suggest each and every feature of claim 10. *Haramishi* is only relied upon a teaching of “a mark indicating a direction.” *Haramishi* does not cure the above-mentioned deficiencies in *Straat*. Thus, the rejection of claim 10 should be withdrawn.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Straat* or *Haramiishi*, whether taken alone or in combination, fails to teach or suggest fail to teach or suggest each feature of independent claim 10, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claims 20-21 depend from independent claim 10. Accordingly, claims 20-21 are also allowable because of the additional features they recite and the reasons stated above.

Conclusion

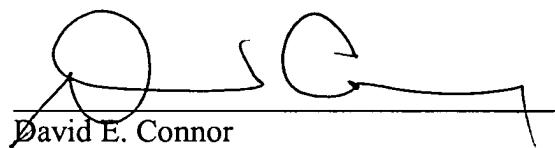
In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of all pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By:


David E. Connor
Reg. No. 59,868

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CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-3001